

D9426

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re amendment to the RICK K. SOUTHERN patent application

Serial No. 10/034,446

Examiner: Phi Dieu Tran A

Filed: December 26, 2001

Art Unit: 3637

For: METHODS FOR ATTACHING SOLID HARDWOOD FLOOR
PLANKS TO CONCRETE FLOOR SURFACES

Office Action mailed: April 15, 2004

Assistant Commissioner of Patents
Box 1450
Alexandria, VA 22313-1450DECLARATION OF RICHARD P. HIRSCH UNDER 37 C.F.R. §1.132

I, Richard P. Hirsch, declare that:

1. I am the Chief Executive Officer of the assignee of the above-identified application. I have been a professional in the flooring business for over the past 42 years. The assignee of the above-identified application, Richard-Marshall Fine Flooring, Inc., has developed expertise in the design, production and installation of solid wood floorboards.
2. I have read the PTO Office Action in the above-identified application mailed April 15, 2004, and have read all of the cited U. S. Patents, including U.S. Patent 3,740,910 ("Taylor"). Respectfully, I disagree with the PTO's assertions about the disclosures in the Taylor patent.

Hirsch Declaration
Appl. No. 10/034,446
July 2, 2004

1

D9426

3. The Taylor patent has nothing to do with forming floor surfaces of any kind. The Taylor patent has nothing to do with forming floor surfaces by attaching wood planks to concrete surfaces. Instead, the Taylor patent is limited to forming wall structures made by adhesively attaching simulated brick panels to drywall surfaces, which contain little or no moisture. By contrast, the flooring structures that we claim in the above-identified application comprise attaching wood planks of three feet in length or longer directly to concrete surfaces that are water-laden.
4. The adhesives disclosed in the Taylor patent for attaching simulated bricks to drywall surfaces to formal wall are called, at column 1, line 59, "waterproof epoxy resin adhesive materials." The only other mention of adhesive materials in the Taylor patent is at column 5, line 9, where Taylor refers to "suitable epoxy resin matrix or adhesive M." These adhesives are not water resistant or water impermeable as called for in the claims of the above-identified application. Rather, as our expert, Joseph J. Grady, attests at paragraph 6 of his Declaration: "The adhesives referred to in the '910 patent (the Taylor patent) are different from, and not interchangeable with, the adhesives identified in the claims of the above-identified application."
5. The products and methods that are the subject matter of our pending claims in the above-identified application have achieved outstanding commercial success. Since June 2002, the assignee of the above-identified application has taken more than 1,000 orders for such products/methods for more than 546,000 square feet of planking on concrete, resulting in more than \$9.3 million in sales. This success is

D9426

I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any registration issued thereon, or any patent to which this verified statement is directed.

This declaration was executed subject to the penalties for perjury under the laws of the State of California, at Los Angeles, California, on July 2, 2004.



Richard P. Hirsch

Hirsch Declaration
Appl. No. 10/034,446
July 2, 2004

3